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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,363	12/22/2000	Tomoo Yamaguchi	Q62262	8173

7590

03/05/2003

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EXAMINER

AHMED, SHEEBA

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-5

Office Action Summary	Application No. 09/742,363	Applicant(s) YAMAGUCHI ET AL.	
	Examiner Sheeba Ahmed	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 24 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-8 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-8 and 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Response to Amendment

1. Amendments to claims 1-8 and 10-18 have been entered in the above-identified application. Claim 9 has been canceled.

Claims 1-8 and 10-18 are now pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-8 and 10-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Sashihara et al. (US 6,251,517 B1).

Sashihara et al. disclose a pressure sensitive adhesive (PSA) composition comprising 100 parts by weight of natural rubber (***thus meeting the limitations of claims 2 and 11***), 50 parts by weight of terpene-phenolic resin (***corresponding to the tackifier of the claimed invention and meeting the limitations of claims 4, 5, 13, and 14***) and 40 parts by weight of an isocyanate hardening agent having three functional groups (***thus meeting the limitations of claims 6, 7, 15 and 16***) (See

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Examples 1 and 2). Example 1 states that a mixture of n-butyl methacrylate and the polymerization initiator was added to the natural rubber, which was already kneaded by a pressure kneader, and then latex polymerization reaction was performed at 80°C. ***(thus meeting the limitations of claims 8 and 17)***. The PSA composition may be prepared as a coating liquid and applied to a support sheet and dried to produce a PSA sheet (Column 7, lines 36-45). The thickness of the coated PSA layer may be 30 microns ***(thus meeting the limitation of claim 10)*** after drying (See Example 1). With regards to the limitation that the natural rubber has a Mooney viscosity of 20 to 100, i.e., ***claims 3 and 12***, the Examiner takes the position that the rubber disclosed by Sashihara et al. inherently meets such a limitation given that the chemical composition and structure of the rubber disclosed by Sashihara et al. and that of the claimed invention are identical. All limitations of the claimed invention are either inherent or disclosed in the above reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sashihara et al. (US 6,251,517 B1)) in view of Applicants own admission.

Sashihara et al., as discussed above, do not specifically teach that the PSA composition is applied to a substrate via calendaring or extrusion coating. However, the Applicants, on Page 1 of the Specification, specifically state that it is known to apply a PSA composition on a substrate via a calender roll coater, extruder or the like. Hence, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to apply the PSA composition disclosed by Ogawa to a substrate via calendaring or extrusion coating given that the Applicants admit that it is known in the art to apply a PSA composition to a substrate via calendaring or extrusion coating.

Response to Arguments

4. Applicant's arguments filed on September 24, 2002 (Paper No. 4) have been fully considered but they are not persuasive. Applicants traverse the rejection of claims 1-8 and 10-17 under 35 U.S.C. 102(e) as being anticipated by Sashihara et al. (US 6,251,517 B1) and submit that Sashihara does not disclose or suggest solvent-free production and in particular employs toluene as the solvent in the examples. However, the Examiner disagrees with the Applicants interpretation of the instantly recited claims and the Sashihara reference. Independent claims 1 and 18 recite a method of producing a solid type pressure sensitive adhesive composition comprising adding a tackifier to a rubbery polymer and the treating the resulting mixture with an isocyanate crosslinking agent, in the absence of a solvent, to crosslink the polymer. In essence, independent claims 1 and 18 only require that the solid type pressure sensitive adhesive be prepared by crosslinking a rubbery polymer using an isocyanate crosslinking agent and in the

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presence of a takifier and the absence of a solvent. Sahsihara meets all such limitations given that Example 1 specifically states that a mixture of n-butyl methacrylate and the polymerization initiator was added to the natural rubber, which was already kneaded by a pressure kneader, and then latex polymerization reaction was performed at 80°C. The solvent, i.e., toluene, is added after the reaction has taken place. Hence, the above rejection is maintained.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (703)305-0594. The examiner can normally be reached on Mondays and Thursdays from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703)308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-5408 for regular communications and (703)305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-5665.



Sheeba Ahmed
March 1, 2003



Paul Thibodeau
Supervisory Patent Examiner
Center for Patent 1700